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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,958	05/10/2001	Arata Tomita	Q64221	4398

7590 11/20/2002
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EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/20/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,958

Applicant(s)

TOMITA, ARATA

Examiner

Steven D. Maki

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 9-11, 15, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 9-11, 15, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/042,642.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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- 1) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 9, 10 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, there is no antecedent basis for "said second sipe".

In claim 18, "sip" should be --sipe--.

- 3) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4) **Claims 7, 9-11, 15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable Japan '204 (JP 2-24204) in view of Europe '300 (EP 391300) and optionally Japan '704 (JP 1-106704).**

In Japan '204, **the sipes are oriented substantially parallel to an edge of the footprint.** This edge can be opposite a tire primary rotating direction depending on how the tire is mounted to the vehicle. Hence, Japan '204 substantially discloses the claimed invention.

Japan '204, directed to restricting heel and toe wear, discloses a pneumatic tire having a tread comprising cuts ("sipes") therein. Japan '204 teaches that the cuts ("sipes") are arranged

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such that the **sipes are substantially parallel to the grounding front edge** of the tire. See abstract. In figure 1, Japan '204 illustrates thin cuts 3 ("sipes") in ribs which are separated by circumferential grooves 1. In figure 4, Japan '204 illustrates the "thin cuts" as being providing in blocks. See abstract in Japan '204. The "cuts" described in the abstract of Japan '204 are sipes. The "ground front edge" described in the abstract of Japan '204 is the leading edge of the ground contacting area (ground contact configuration, footprint) of the tire. The sipes in Japan '204 are therefore substantially parallel to the leading edge (and a contour line tangent thereto) at the same axial distance from the equatorial plane of the tire.

With respect to the trailing edge, the following is set forth: As to claims 11, 18 and 19, it would have been obvious to one of ordinary skill in the art to provide the tire of Japan '204 such that the footprint (ground contacting area) is **symmetrical** - the leading edge and trailing edge of the footprint (ground contacting area) thereby extending in opposite directions but having the same curved shape since it is well known / conventional in the tire art to provide a tire such that its footprint / ground contacting area is symmetrical as shown by Europe '300. Europe '300 provides ample suggestion to provide the footprint / ground contacting area of Japan '204 such that it is symmetrical. With respect to the symmetrical footprint, Europe '300 teaches that the symmetrical footprint shown in figure 1 efficiently removes water on a wet road surface. and that the symmetrical footprint illustrated in figure 4 is "the footprint shape of a conventional pneumatic tire" (page 2 line 52). The applied art therefore provides clear guidance that the footprint of

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Japan '204 can and should be symmetrical. Indeed, there is no suggestion in the prior art to use an asymmetric footprint in Japan '204.

With respect to this rejection, the following is noted: First: The leading edge of a footprint of a tire rotating in one direction *becomes* the trailing edge of the footprint when the tire rotates in a direction opposite to that of the one direction. **Second:** When the footprint of Japan '204 is **symmetrical**, the sipes are parallel to the leading edge of the footprint during rotation of the tire in one direction and the sipes are parallel to the trailing edge of the footprint during rotation of the tire rotates in an opposite direction. In short, the claimed tire requires a sipe to be substantially parallel to an edge of a ground contacting area and this subject matter is expressly disclosed in the abstract of Japan '204.

As can be seen from the prosecution of the parent 09/042642, applicant and examiner are apparently in agreement as to all issues surrounding claims 7, 9-11, 15, 18 and 19 *expect* the issue as to the meaning of "are inclined opposite a tire primary rotating direction". **First:** The examiner *disagrees* with applicant's statement that "[t]he Examiner is of course correct that the leading edge becomes the trailing edge if the rotational direction of the tire reverse, however, the claims are not that broad." (page 4 response filed 2-6-01). **Second:** Applicant's comment that the "...artisan would have no difficulty in understanding that the primary direction of rotation refers to only one direction of rotation of the tire" is off point since "are inclined opposite a tire primary rotating direction" relates to intended use instead of a structural feature of the tire. **Third:** What *structural difference*, if any, is required by "tire primary rotational direction"? Applicant has

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provided no answer to this question. Does “tire primary rotational direction” exclude a “non-directional tread”? If so, then does “tire primary rotational direction” exclude the non-directional tread pattern illustrated in figure 1 of applicant’s disclosure? If not, why not? Does “tire primary rotation direction” fail to enable the tire to be mounted (i) in opposite directions on the same vehicle? If so, what structural difference fails to so enable the tire? Since applicant has not identified any structure required by “tire primary rotational direction”, “tire primary rotational direction” merely relates to intended use and fails to require a structural difference from the tire suggested by the applied prior art. Furthermore, **there is a failure to establish a tire primary rotating direction until the tire is mounted to a vehicle.** Claims 7, 9-11, 15, 18 and 19 fail to require the tire to be mounted to a vehicle. The mounting of the tire to a vehicle is the “intended use”. If “tire primary rotating direction” is defined by structure (e.g. tire structure such as sidewall configuration) instead of the *intended mounting of the tire on the vehicle*, then applicant has failed to describe such structure.

As to claims 7, 9-10 and 15, note that Japan ‘204 provides sipes in shoulder blocks and intermediate blocks.

The claimed grooves read on the grooves shown in figure 4 of Japan ‘204. In any event, it would have been obvious to one of ordinary skill in the art to provide the pneumatic tire of Japan ‘204 (which has a tread comprising thin cuts / sipes arranged so as to be parallel to the front grounding edge of the tire) such that the sipes are provided in blocks defined by *circumferential grooves and transverse grooves*, since it is well known / conventional in the tread art to provide

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sipes in blocks *which are defined by circumferential grooves and transverse grooves* as exemplified by Japan '704.

5) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6) **Claims 7, 9-11, 15, 18 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6283184.**

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 7, 9-11, 15, 18 and 19 fail exclude a combination of two different sipes

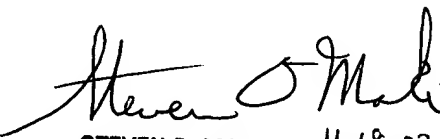
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wherein the other sipe is a sipe which is substantially parallel to a contour line at a leading edge of the footprint. The limitations regarding shoulder blocks and blocks adjacent thereto would have been obvious in view of the limitation of claim 4 of US 6283184.

Remarks

- 7) No claim is allowed.
- 8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (703) 308-2068. The examiner can normally be reached on Monday to Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be reached on (703) 308-2058. The fax phone number for Art Unit 1733 is (703) 872-9310 for regular communications and (703) 872-9311 for after final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Steven D. Maki
November 18, 2002


STEVEN D. MAKI 11-18-02
PRIMARY EXAMINER
~~GROUP 1300~~
AU 1733